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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHAKRABARTI, ARUN K

ART UNIT PAPER NUMBER

1634

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory ActionApplication No.
09/916,179Applicant(s)
GraafExaminer
Arun ChakrabartiArt Unit
1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun 25, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Jun 25, 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 20-38

Claim(s) objected to: 2, 3, 15, and 16

Claim(s) rejected: 1, 4-14, and 17-19

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other:

The proposed amendment of adding new claims 73 and 74 will not be entered because the negative limitation "wherein the nucleic acid molecule is not hPFTAIRE or beta1-3N-acetylglucosaminyltransferase" raise new issues that would require further consideration and search and raise the issue of new matter. (See MPEP 2173.05 (I)) -- "Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement". In the instant application, negative limitations "wherein the nucleic acid molecule is not hPFTAIRE or beta1-3N-acetylglucosaminyltransferase" inserted in the new claims do not have any expressed basis in the original specification (Figures 1A-1U) or claims (as described in page 3 of Remarks section). New claims 73 and 74 present additional claims without canceling a corresponding number (two in this case) of finally rejected claims.

Claims 71 and 72 have not been entered in the application because they depend on non-elected and therefore non-existent claim 70.

The request for reconsideration of claims 1, 4-14 and 17-19 has been considered but does not place the application in condition for allowance because of the following reason:

Applicant argues (page 5, first and second paragraph) that none of the references teach the main feature and limitation of the claims i.e., determining an expression profile from expression products of at least three informative nucleic acid molecules. This argument is not persuasive. Arnold (U.S. Patent 6,423,535 B1) clearly teaches "determining an expression profile from expression products of at least three informative nucleic acid molecules" (Column 7, lines 7-24

and Examples 1 and 3).

Applicant argues (Page 5, third paragraph to page 6, second paragraph) that there is no motivation to combine the references and if there is any it is different from the applicant's motivation. This argument is not persuasive. Arnold clearly provides motivation as Arnold states, "The invention thus provides quantitative information on each element of the microarray. Another advantage of the invention is that the hybridization of the probe sequence and the standard sequences is not competitive, thereby reducing noise in the results (Column 7, lines 19-24)". In response to applicant's argument that Arnold's motivation is different from the applicant's motivation, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant also argues (page 6, third paragraph to page 8, first paragraph) that references cited to reject claims 13 and 19 does not teach each element of the claims individually. Therefore, 103(a) rejection against these claims should be withdrawn. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In view of the response to request for reconsideration of claims 1, 4-14 and 17-19, the instant claims are not in condition of allowance and therefore not entered.


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